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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,437	03/25/2004	Masami Suwama	2004-0483A	6940

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/808,437	Applicant(s) SUWAMA ET AL.	
	Examiner William P. Fletcher III	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/14/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Receipt is acknowledged of applicant's amendment and response filed 14 Nov. 2005. Claims 1-13 and 16-21 are pending of which claims 20 and 21 are withdrawn from consideration.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 14 Nov. 2005 was filed after the mailing date of the first Office action on 13 Jul. 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Response to Arguments***

3. Applicant's arguments, see the response, filed 14 Nov. 2005, with respect to the objections set-forth in the prior Office action, have been fully considered and are persuasive. The objections have been withdrawn.

4. Applicant's arguments, see the response, filed 14 Nov. 2005, with respect to the rejections set-forth at items 11 and 12 of the prior Office action, have been fully considered and are persuasive. These rejections have been withdrawn.

5. The subject matter of claims 14 and 15 has been incorporated into independent claim 1. Applicant's arguments with respect to former claims 14 and 15 have been fully considered and are persuasive. Rink does not, in fact, teach applicant's claimed component (C). However, upon further consideration, a new ground(s) of rejection is made in view of Rink and Marutani et al. (US 6,040,009 A). Consequently, this Office action is non-final.

Art Unit: 1762

6. Applicant's arguments filed 14 Nov. 2005, with respect to the rejection of the term "rigid" under 35 USC 112, 2<sup>nd</sup> Para., have been fully considered but they are not persuasive. The second paragraph of 35 USC 112 states: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention.<sup>1</sup> Because the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, is appropriate.<sup>2</sup> As asserted in the prior Office action, "rigid" is a relative term. It is not the examiner's contention that the term "rigid" is not known. Rather, because the criteria by which one may determine which substrates are rigid and which are not, within the context of the instant invention, are not known or disclosed, the metes and bounds of the term are impossible to determine. The mere appearance of the term in the claim of an unrelated US patent does not establish whether the term is definite within the context of the instant invention, addressing the concerns over the metes and bounds of the term. Consequently, this argument is not persuasive.

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<sup>1</sup> MPEP 2173

<sup>2</sup> MPEP 2173.02

Art Unit: 1762

7. The declaration under 37 CFR 1.132 filed 14 Nov. 2005 is insufficient to overcome the rejection of claims 1-19 as set forth below because: Marutani explicitly suggests the incorporation of applicant's claimed component (C) for the same reasons set-forth by applicant (i.e., hardness, etc.). Consequently, because expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof,<sup>3</sup> the declaration does not weight against the *prima facie* case below.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The term "rigid" in claim 1 is a relative term which renders the claim indefinite. The term "rigid" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. While applicant provides examples of suitable "rigid resin parts," such as the plastic automotive parts disclosed at page 3, lines 4-12 of the specification, applicant provides no explicit definition of the term "rigid." An ordinary dictionary definition of the term is "stiff or unyielding; not pliant or flexible; hard."<sup>4</sup> This definition is still relative because an object may only be considered rigid, stiff, or inflexible with respect to an applied force. An object that is rigid with respect to one applied force may be

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<sup>3</sup> MPEP 716.02(c)

Art Unit: 1762

easily deformed by another, greater applied force. Consequently, because the term “rigid” is not defined with respect to a standard (such as an applied force, flexural strength, etc.), one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of the claimed invention.

Claims 2-19 are similarly rejected by virtue of their incorporation of this indefinite subject matter.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. **Claims 1, 3-13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rink et al. (US 6,013,739 A) in view of Marutani et al. (US 6,040,009 A).**

Rink is detailed in the prior Office action and applied again here for the same reasons.

This reference does not explicitly teach that the clear paint further comprises 1-20% by weight of hydroxyl-containing oligomer (C) which is a reaction product of a carboxyl-containing

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<sup>4</sup> *The American College Dictionary*, page 1045, attached to prior Office action.

Art Unit: 1762

compound with an epoxy-containing compound, based on the combined solid content of the acrylic resin (A) and the curing agent (B).

Rink teaches that, in addition to components (A) and (B), the composition may additionally include “one or more other hydroxyl group-containing resins, whereby, for example, the solvent resistance and hardness of the resulting coating are improved further. For example, they may contain...polyesters. These further binders are usually employed in a quantity of from 0 to 25% by weight...” (8:51-62).

Marutani teaches that the use of star-type polyesters, that are the reaction product of a carboxyl-containing compound with an epoxy-containing compound, in paint coating compositions advantageously permits a reduction in the amount of environmentally-unfriendly VOC as well as improved adhesion and chipping resistance (i.e., hardness) (6:35-7:13).

Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Rink so as to incorporate, as the 0 to 25% by weight of one or more other hydroxyl group-containing resins, whereby, for example, the solvent resistance and hardness of the resulting coating are improved further, the star-type polyesters of Marutani. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully reducing the VOC of the coating composition and improving the hardness of the resulting coating.

**13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rink et al. in view of Marutani et al., as applied to claim 1 above, further in view of Asahina et al. (US 5,817,732 A) and Croft (US 5,688,860 A).**

The teaching of Rink and Marutani is detailed above.

Art Unit: 1762

Asahina and Croft render this claim obvious for the reasons set-forth at item 16 of the prior Office action.

***Conclusion***

14. Applicant has cited several documents cited as X references in a foreign search report. As noted above, these references have been considered. They do not read on the claim because they neither teach nor suggest applicant's claimed component (C).

15. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

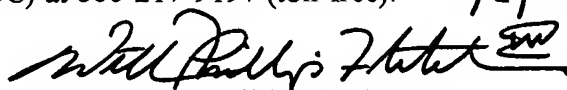
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/6/2006



William Phillip Fletcher III  
Patent Examiner, USPTO  
Art Unit 1762